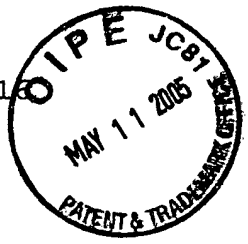
JFW

HT-03-013



May 6, 2005

To: Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Attn: Art Unit 2815 - Joseph H. Nguyen

From: George O. Saile, Reg. No. 19,572

28 Davis Avenue

Poughkeepsie, N. Y., 12603

Subject: | Serial No.: 10/820,391 04/08/04 |

Cheng T. Horng et al.

A NOVEL OXIDATION STRUCTURE/METHOD TO FABRICATE A HIGH-PERFORMANCE MAGNETIC TUNNELING JUNCTION MRAM

|_ Art Group: 2815 Joseph H. Nguyen _|

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Restriction or Election Requirement in the Office Action dated 04/27/05. In that Office Action, restriction was required to one of two stated

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 9 , 2005.

Stephen B. Ackerman, Reg.# 37761

Signature/Date  May 9, 2005

Inventions under 35 U.S.C. 121. The Inventions stated are Group I - Claims 1-13 to a magnetic tunneling junction, classified in Class 257, subclass 295 and Group II - Claims 14-26 to a process, classified in Class 438, subclass 1+.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group II - Claims 14-26 drawn to a process classified in Class 438, subclass 1+. This election is made with traverse of the requirement under 37 C.F.R.1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction given in the Office Action. The Examiner gives the reason for the distinctness of the two inventions as (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). However, upon reading the product Claims against the process Claims one can readily see that the product Claims are directed to "a magnetic tunneling junction (MTJ) device in an MRAM configuration" and the process Claims are directed to "a method of forming a magnetic tunneling junction (MTJ) MRAM device", it is necessary to obtain claims in both the product and method claim language. The method Claims necessarily use the product and vice versa. The field of search must necessarily cover both the method

class/subclass 438/1+ and products class 257/295 in addition to other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group I and Group II inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "In the instant case, unpatentability of the Group I invention would not necessarily imply unpatentability of the Group II invention, since the product of the Group I invention could be made by another and materially different process from those of the Group II invention. For example, as an alternative to claim 14, chemical etching the Ta capping layer instead of sputter etching", is very speculative and really has nothing to do with the Claims as presented in this Patent Application. Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of a second Patent Application upon the Applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement and the Allowance of the present Patent Application is requested.

Sincerely,

Stephen B. Ackerman, Reg. #37761